

REMARKS

This application has been reviewed in light of the Office Action mailed March 16, 2007.

Reconsideration of this application in view of the below remarks is respectfully requested.

Claims 3, 5, 8 – 10, 16 – 18, 20 – 21, 25 and 28 – 29 are currently elected for continued prosecution with Claims 3, 8, 16, 18, 25, 28 and 29 being in independent form. By the present amendment, Claims 3, 8, 16, 18, 25, 28 and 29 have been amended.

Specifically, Claims 3, 8, 16, 18, 25, 28 and 29 have been amended to recite that the at least one network identifier in the second list is an identifier of a network that is never to be used. As this amendment to the claims merely clarifies the limitation, no new subject matter has been introduced into the disclosure by way of the present amendment.

I. Rejection of Claims 28 and 29 Under 35 U.S.C. § 102(e)

Claims 28 and 29 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,148,197 issued to Bridges et al.

Bridges discloses that “the entries in the PSL/IRDB should be prioritized, and the mobile station can truncate the PSL/IRDB once the maximum storage capacity is reached.” (See: Col. 11, lines 36 – 38). However, Bridges fails to disclose or suggest that the at least one network identifier in the second list is an identifier of a network that is not to be used.

Moreover, the mobile station disclosed in Bridges et al. compares the received single identity against the plurality of identities maintained on the mobile station. Consequently, the mobile station of Bridges et al. does not compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover, as recited in Applicant’s Claim 28, and similarly recited in Claims 3, 8, 16, 18, 25 and 29.

Contrary to the assertion in the present Office Action, the Bridges et al. passages cited, namely col. 12, lines 66 – 67 and col. 13, 34 – 38, do not disclose Applicant's claimed first list including a plurality of network identifiers. The cited passages disclose that in situations where multiple service providers exist in a given area, the PSL/IRDB stored on a mobile station may comprise a table of multiple SIDs and/or SOC's and their corresponding frequency bands. (See: Bridges et al.: col. 11 – 15 and col. 25 – 29). Thus, this list is equivalent to Applicant's second list that is stored in the mobile station, because no disclosure is provided in Bridges et al. that the table is a received list.

Instead, Bridges et al. discloses that each service provider sends its own network identifier. Therefore, the user equipment in Bridges et al. receives each network identifier individually, not as a list as recited in Applicant's independent claims.

In addition, the process of selecting the most appropriate system for a region, as disclosed in col. 12, lines 1 – 6 of Bridges et al., is not a comparison. A selection can be made using a multitude of methods none of which involve comparing. Therefore, simply citing a passage in Bridges et al. that discloses selecting would not be suggestive of performing a comparison to one of ordinary skill in the art.

Moreover, the Examiner seems to suggest that since Bridges et al. discloses a preferred system identification list (PSL) from which the most appropriate system is selected by the mobile station, the unselected/unused systems are equivalent to Applicant's claimed at least one network identifier in the second list being an identifier of a network that is not to be used. This reading of the Bridges et al. PSL is contrary to any proper interpretation. While a particular system listed in the PSL may not be used at any given moment, that same system is not precluded from being used at some other time by the mobile station in Bridges et al.. In contrast, the at least one

network identifier in the second list that is not to be used is designated to never be used by the mobile station. Therefore, the Bridges et al. list of preferred system identifiers does not anticipate Applicant's at least one network identifier in the second list being an identifier of a network that is not to be used.

It is well-settled by the Courts that "[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company, et al., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984).

Therefore, as demonstrated above, because Bridges et al. does not disclose each and every element recited in the present claims, Applicant respectfully submits that the rejection has been obviated. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 28 and 29 under 35 U.S.C. § 102(e).

II. Claims 3 and 25 Under 35 U.S.C. § 103(a)

Claims 3 and 25 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,940,761 issued to Tiedemann, Jr. et al. in view of Bridges et al.

As indicated above, Bridges et al. does not properly disclose or suggest transmitting to the user equipment a first list having a plurality of unique network identifiers, as recited in Applicant's Claim 3; means for receiving by a user equipment a first list including a plurality of unique network identifiers, as recited in Claim 25; or at least one network identifier in the second list being an identifier of a network that is never to be used, as recited in both Claims 3 and 25.

Tiedemann, Jr. et al. teaches a method for performing mobile assisted hard handoff between communication systems having a system preference table. However, Tiedemann, Jr. et al. does not overcome the above-identified deficiencies in Bridges et al. Specifically, Tiedemann,

Jr. et al. does not disclose or suggest transmitting to, or receiving by, a user equipment a first list including a plurality of unique network identifiers; nor at least one network identifier in the second list being an identifier of a network that is never to be used. Thus, Tiedemann, Jr. et al. and Bridges et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

Therefore, for at least the reasons given above, Claims 3 and 25 are believed to be allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 3 and 25 under 35 U.S.C. § 103(a) over Bridges et al. in view of Tiedemann, Jr. et al.

III. Claims 16 - 18 and 20 Under 35 U.S.C. § 103(a)

Claims 16 - 18 and 20 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,223,030 issued to Van Den Heuvel et al. in view of Bridges et al.

As presented above, Bridges et al. does not properly disclose or suggest means for receiving a first list from the active network, the first list having a plurality of unique network identifiers, and at least one network identifier in the second list being an identifier of a network that is never to be used, as recited in Claims 16 and 18.

Van Den Heuvel et al. fails to overcome the deficiencies identified in Bridges et al. Specifically, Van Den Heuvel et al. does not disclose or suggest means for receiving a first list from the active network, the first list having a plurality of unique network identifiers, and at least one network identifier in the second list being an identifier of a network that is never to be used. Thus, Van Den Heuvel et al. and Bridges et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

Therefore, for at least the reasons given above, Claims 16 – 18 and 20 are believed to be allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 16 – 18 and 20 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al.

IV. Claims 5 and 8 – 10 Under 35 U.S.C. §103(a)

Claim 5 is rejected under 35 U.S.C. §103(a) as allegedly obvious over Tiedemann, Jr. et al. in view of Bridges et al., and further in view of U.S. Patent No. 6,272,315 issued to Chang et al.; and Claims 8 – 10 are rejected under 35 U.S.C. §103(a) as allegedly obvious over Van Den Heuvel et al. in view of Bridges et al., and further in view of Chang et al.

Chang et al. discloses a mobile satellite system and terrestrial wireless system networking technique for switching a mobile unit between a mobile satellite system mode and a terrestrial wireless system mode. Additionally, Chang et al. teaches adding a system ID of a network to the bottom of a list of system IDs stored in a memory of a mobile terminal. However, Chang et al. fails to overcome the above-identified deficiencies present in Tiedemann, Jr. et al., Van Den Heuvel et al. and Bridges et al. Thus, Tiedemann, Jr. et al., Van Den Heuvel et al., Bridges et al., Chang et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

Therefore, for at least the reasons given above, Claims 5 and 8 – 10 are believed to be allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claim 5 under 35 U.S.C. § 103(a) over Tiedemann, Jr. et al. in view of Bridges et al., and further in view of Chang et al.; and Claims 8 – 10 under 35 U.S.C. §103(a) over Van Den Heuvel et al. in view of Bridges et al., and further in view of Chang et al.

V. Claim 21 Under 35 U.S.C. §103(a)

Claim 21 is rejected under 35 U.S.C. §103(a) as allegedly obvious over Van Den Heuvel et al. in view of Bridges et al, in further view of U.S. Patent No. 6,584,116 issued to Gourgue et al. Claim 21 depends from independent Claim 16 and thus includes the limitations recited in that independent claim.

Gourgue et al. discloses a UMTS network and a GSM network, and a method of handover to a GSM network from a UMTS network during a call originating in a UMTS network. However, Gourgue et al. fails to overcome the above-identified deficiencies present in Van Den Heuvel et al. and Bridges et al. Thus, Gourgue et al., Van Den Heuvel et al. and Bridges et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

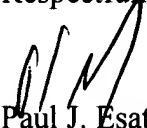
Therefore, for at least the reasons given above, Claim 21 is believed to be allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claim 21 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al, in further view of Gourgue et al.

CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3, 5, 8 – 10, 16 – 18, 20 – 21, 25 and 28 – 29 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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